

REMARKS

Claims 1 – 11 and 15 – 21 remain in this application.

Election

The Examiner has rejected Applicant's assertion that claim 18 is generic to claim 4, and has withdrawn claims 1 – 3, 8 – 11 and 15 – 19 from consideration. This appears to be in error and the Examiner is requested to reconsider this finding and examine all claims. Claim 4 has been slightly amended to recite that the magnetic plates are "thin" as in claim 18.

The claims comprise two independent claims, 4 and 18. It is indisputable that if claim A contains *all the limitations* of claim B, plus additional limitations, Claim B is generic to claim A.

In this application, Claim 18 recites a method comprising the following four steps:

- a. *making thin magnetic plates with low hysteresis loss,*
- b. *providing insulating material,*
- c. *making a stack of a plurality of said plates,*
- d. *inserting a thin film of insulating material between adjacent plates of said stack, and*
- e. *applying heat and/or pressure to the stack to cohere the stack.*

Claim 4 contains the following same limitations as claim 18"

- a) making thin magnetic plates with low hysteresis loss,
- b) making thin insulating films, (= "*providing insulating material*")
- d) making a stack by alternating layers of magnetic plates and insulating films, (= "*making a stack of said plates*" and "*inserting a thin film of insulating material between adjacent plates of said stack*"),
- e) *applying pressure and/or heat to the stack,*

and adds the following limitation:

- c) *depositing an adhesive on both sides of the insulating films.*

Therefore, claim 18 is generic to claim 4 and claim 18 is generic to all other claims that contain all of the limitations of claim 18, plus others.

Accordingly, the Examiner is requested to examine all of claims 1 – 11 and 15 – 21.

Title

A new title has been presented as suggested by the Examiner.

Claim Rejections

Claims 4 and 7 were rejected under 35 USC§103 as unpatentable over the combination of Muraoka and Zoche. Neither of these references is relevant, since they do not relate to making low loss, high frequency composite magnetic material, which is the reason for Applicant's invention. The material is a new patented material (see parent U.S. Patent No, 6660412). Since the material being made is non-obvious, the method of making it can be obvious only to the inventor.

As the Examiner notes, Muraoka is making a completely different type of material. His method bears no resemblance to that of claim 4 or 18. There is no disclosure of making alternating layers of *magnetic plates* and insulating films. In Fig. 14, Muraoka has two different types of substrates 9 and 11 which sandwich a stack of substrates 10 – all of which comprise a **non-magnetic** substrate coated with an adhesive glass film. (see column 7, lines 19 – 34) **There are no magnetic plates** which alternate with **thin insulating films**. The Examiner is challenged to **specify** how the reference disclosure meets each step of the claimed methods of claims 4 and 18.

Muraoka's methods bear no resemblance to that disclosed and claimed by Applicant. Applicant makes thin magnetic plates with low hysteresis loss. Muraoka has no such **plates** – only coated non-magnetic substrates! There are no alternating non-magnetic thin insulating films

Zoche adds nothing, since it discloses no method of making anything. This patent does not disclose Applicant's claimed **low loss, high frequency composite magnetic material**. Zoche is drawn to an article, not a method. Applicant's aforementioned patent covers the Applicant's inventive article. \

This application is drawn to the method of making that composite, high frequency magnetic material, which includes the step of making thin magnetic plates with low hysteresis loss. None of this is shown, taught, or suggested by either Muraoka or Zoche. As such, there is no incentive to combine these two references, and no suggestion or teaching of the methods claimed in claims 4

and 18, even if they are combined. It is inconceivable that anyone could read Muraoka and Zoche and devise anything remotely resembling the methods claimed in Applicant's claims 4 and 18, or any of their dependent claims.

The Examiner has failed to establish the "prima facie case of obviousness" required by the Federal Circuit:

"The PTO has the burden under section 103 to establish a **prima facie** case of obviousness. [citation omitted] It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings in the references. **"In re Fine**, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

It is submitted that the Examiner is committing the ancient sin of combining references in light of Applicants' disclosure.

In view of the above, the Examiner is requested to reconsider and withdraw all grounds of rejection and allow all of claims 1 – 11 and 15 – 21.

Respectfully submitted,

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This certifies that this Response and Amendment was sent via facsimile to the USPTO, Art Unit 3729 at (703) 872-9306 on February 16, 2005 by

